

REMARKS

Claims 1-17 are all the claims pending in the application. New claim 17 has been added to further define the invention. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1 and 9 under §103(a) as being unpatentable over JP-1122753 (using US Patent 6,170,625 to Tanaka as an English equivalent) (hereinafter Tanaka) in view of JP-2000-119673 (using US Patent 6,329,326 to Iso et al. as an English equivalent) (hereinafter Iso) and further in view of US Patent 5,655,844 to Takano (hereinafter Takano). Applicants respectfully traverse this rejection for the following reasons.

First, Applicants remarks as set forth in the Amendment filed on September 22, 2003 are still pertinent and, therefore, are incorporated herein by reference.

Second, Applicants submit that the Examiner's "Response to Arguments" is flawed for the following reasons.

The Examiner incorrectly asserts that Applicants argue against the references individually.¹ Although each of the references individually is discussed in Applicants' remarks, such is done in the context of showing that there is no motivation for the Examiner's suggested combination. In fact, it is the Examiner who fails to consider the references as a whole and, instead, impermissibly selectively picks and chooses various parts of disparate references just because all are directed to the very broad category of "bearings". However, not all bearings are the same, and various types have different considerations, which depend at least in part upon their loading conditions as determined at least in part by the apparatus in which they are disposed. Accordingly, the considerations applicable to Takano's bearing—as disposed in a screw compressor—are not necessarily transferable to the bearings disposed in Tanaka's pulley unit. That the Examiner fails to consider the references as a whole is evidenced by the fact that

¹ Office Action at page 10, lines 1-6.

she relies upon “Iso ... **solely** for the teaching of the lubricant being grease, and the Takano reference ... **solely** for the teaching of a bearing effective clearance having a positive value ...”²

In light of the above, this rejection is believed to be in error and should be withdrawn.

The Examiner rejected claims 2 and 10 under §103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of US Patent 4,371,220 to Brucher (hereinafter Brucher). Applicants respectfully traverse this rejection for the following reasons.

As noted above, the Examiner’s attempted combination of Tanaka, Iso, and Takano, is improper. Brucher does not teach anything that would make the Examiner’s attempted combination proper. Accordingly, this rejection is believed to be in error and should be withdrawn.

The Examiner rejected claims 3 and 11 under §103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of US Patent 4,629,337 to Teramachi (hereinafter Teramachi). Applicants respectfully traverse this rejection for the following reasons.

As noted above, the Examiner’s attempted combination of Tanaka, Iso, and Takano, is improper. Teramachi does not teach anything that would make the Examiner’s attempted combination proper. Accordingly, this rejection is believed to be in error and should be withdrawn.

The Examiner rejected claims 4 and 12 under §103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Brucher and Teramachi. Applicants respectfully traverse this rejection for the following reasons.

As noted above, the Examiner’s attempted combination of Tanaka, Iso, and Takano, is improper. Brucher and Teramachi do not teach anything that would make the Examiner’s attempted combination proper. Accordingly, this rejection is believed to be in error and should be withdrawn.

² Office Action at page 10, lines 6-11 (emphasis added).

The Examiner rejected claims 5 and 13 under §103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of US Patent 4,465,195 to Dreschmann et al. (hereinafter Dreschmann). Applicants respectfully traverse this rejection for the following reasons.

As noted above, the Examiner's attempted combination of Tanaka, Iso, and Takano, is improper. Dreschmann does not teach anything that would make the Examiner's attempted combination proper. Accordingly, this rejection is believed to be in error and should be withdrawn.

- The Examiner rejected claims 6 and 14 under §103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Brucher and Dreschmann. Applicants respectfully traverse this rejection for the following reasons.

As noted above, the Examiner's attempted combination of Tanaka, Iso, and Takano, is improper. Brucher and Dreschmann do not teach anything that would make the Examiner's attempted combination proper. Accordingly, this rejection is believed to be in error and should be withdrawn.

The Examiner rejected claims 7 and 15 under §103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Teramachi and Dreschmann. Applicants respectfully traverse this rejection for the following reasons.

As noted above, the Examiner's attempted combination of Tanaka, Iso, and Takano, is improper. Teramachi and Dreschmann do not teach anything that would make the Examiner's attempted combination proper. Accordingly, this rejection is believed to be in error and should be withdrawn.

The Examiner rejected claims 8 and 16 under §103(a) as being unpatentable over Tanaka in view of Iso and Takano, and further in view of Brucher, Teramachi, and Dreschmann. Applicants respectfully traverse this rejection for the following reasons.

As noted above, the Examiner's attempted combination of Tanaka, Iso, and Takano, is improper. Brucher, Teramachi and Dreschmann do not teach anything that would make the Examiner's attempted combination proper. Accordingly, this rejection is believed to be in error and should be withdrawn.

New Claim


Applicants have added new claim 17 to further define the invention. Claim 17 sets forth that the positive value of the radial clearance is "such that the contact position of the rolling element with respect to the raceway surface of the inner ring is gradually shifted when the relative rotation between inner and outer rings is zero". Not all radial clearances produce such a result. Note Fig. 4, wherein a radial clearance of 0.01 mm does not produce the desired result as set forth in claim 17. None of the references teaches or suggests that the clearance is sized so that the contact position of the rolling element with respect to the raceway surface of the inner ring is gradually shifted when the relative rotation between inner and outer rings is zero, as set forth in claim 17.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Jeffrey A. Schmidt
Registration No. 41,574

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: June 8, 2004